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10/530,670	04/07/2005	Dharam Pal		7351

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INDIA

EXAMINER
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POPHAM, JEFFREY D

ART UNIT	PAPER NUMBER
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2437

MAIL DATE	DELIVERY MODE
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11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,670	<b>Applicant(s)</b> PAL, DHARAM	
	<b>Examiner</b> JEFFREY D. POPHAM	<b>Art Unit</b> 2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Remarks***

Claims 1-17 are pending.

***Election/Restrictions***

1. Applicant's election of group II, claims 17-18 in the reply filed on 10/9/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). It is noted here that there are 2 claims marked as claim 16 (further discussion is provided below), however, the elected group II comprises the second claim 16 and claim 17 (corresponding to claims 17-18 of the PCT). Therefore, claims 1-15 and the first claim marked 16 (the dependent claim) are withdrawn from further consideration, while the second claim 16 (the independent claim) and claim 17 dependent upon this claim 16 are discussed in this office action.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Singapore on 11/1/2002 and a PCT filed on 10/27/2003. It is noted, however, that applicant has not filed a certified copy of the Singapore application (200206571-2) as required by 35 U.S.C. 119(b).

***Claim Objections***

3. Claims 16 and 17 are objected to because of the following informalities:

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- There are 2 claims referred to as claim 16 in the current set of claims. However, when viewing the corresponding PCT, one can see that the claims are properly numbered as 1-18. For purposes of this office action, the elected group of claims (the 2 full claims on page 17, numbered 16 and 17) are referred to as claims 16 and 17. It is to be understood that the claim 16 dependent upon claim 1 has been considered withdrawn as being directed to a non-elected invention, and that the only claim 16 referred to in the rejections below is independent claim 16 from page 17 of the application. However, when responding to this office action, these claims must be renumbered such that they are claims 17 and 18 (as in the PCT) or in a like manner (such as by cancelling the current claims and adding new corresponding claims) such that there are no duplicated claim numbers. Additionally, if claims are added, they must have the proper numbering after this correction.
- Claim 16 has multiple sentences, which is not allowed within a single claim (see MPEP § 608.01(m)).
- Claims 16 and 17 also appear to be informal, much like the written description should be. Such informal claim language also ambiguous, not clearly defining the boundaries of the claims. Examples of such ambiguous language are use of "etc." in claim 16 and "can" in claim 17.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 16-17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 16 is directed to a “functionality” and provides an informal description of limitations. This functionality is not a process, machine, composition of matter, or manufacture. This claim appears to be closest to a process, and a very simple example is now given for how to properly claim a process:

A method, executed by a processor, for creating and sending an email, said method comprising:

creating an email;  
defining recipients of said email; and  
transmitting said email to said recipients.

Please keep in mind that this is a simple example, and, if Applicant wishes to use such language as the method being executed by a processor, there must be basis for this within the application as originally filed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Basson (U.S. Patent Application Publication 2003/0131057).

Basson discloses a functionality whereby a sender of an email is able to incorporate a confidential comment, message, or narration meant only for particular recipients or a group of recipients in a TO/CC/BCC list and such recipients of the email are able to open and read the email in confidence (Figures 1-2; and Paragraphs 9-10 and 20-21);

Wherein the functionality shall be made available to users of email services irrespective of email applications and systems, such that users of any kind of email service or application are able to send and receive an email (Abstract; Figures 1-2; and Paragraphs 9-10 and 20-21).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Basson in view of Koelzer (Koelzer, Bill, "Avoid E-mail Carbon Copy Disasters", 7/23/2002, pp. 1-3, obtained from [https://realitytimes.com/rtpages/20020723\\_emailCC.htm](https://realitytimes.com/rtpages/20020723_emailCC.htm)).

Basson does not explicitly disclose that a user of the service can view all email addresses that were there in the BCC list of an email sent by the user at a later date if the user has retained a copy of the email in a sent emails folder.

Koelzer, however, discloses that a user of the service can view all email addresses that were there in the BCC list of an email sent by the user at a later date if the user has retained a copy of the email in a sent emails folder (Pages 1-3). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the BCC use and verification techniques of Koelzer in order to allow a user of the system to send blind carbon copies of an email such that any recipient will not see any BCC names/addresses addressed to anyone other than that recipient and/or to allow a user to verify everyone that was sent an email by using BCC, such that there is no ambiguity as to the recipients that received the email.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY D. POPHAM whose telephone number is (571)272-7215. The examiner can normally be reached on M-F 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D Popham  
Examiner  
Art Unit 2437

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Examiner, Art Unit 2437

/Emmanuel L. Moise/  
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